

80



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,412	02/14/2001	Danny Soroker	6727/01290	4685

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EXAMINER

BAYARD, DJENANE M

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,412

Applicant(s)

SOROKER ET AL.

Examiner

Djenane M. Bayard

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☒ Claim(s) 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to Amendment received on 1/18/2005 in which claims 21-40 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 21-23 have been considered but are moot in view of the new ground(s) of rejection. Therefore, this case is made **Final**.

3. As per claims 21, 22 and 23, Applicant argues that Watanabe fails to teach or suggest "sending an e-mail message with an attachment, and saving said e-mail message without said attachment". However, Watanabe clearly teaches where the attachment is appended to e-mail addresses indicated by the address selective file appendage information. (See col. 10, lines 27-33). Furthermore, Watanabe clearly teaches where the "transmission determination part dictated that attachment files are to be appended to e-mail only destined for mail addresses indicated by the address-selective file appendage information (See col. 10, lines 62-67).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 2141

5. Claim 24 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "saving the e-mail message, without the attachment comprises saving the e-mail message without the attachment on a computer of the sender" was not found in the specification.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 21-26, 29-31, 34-37 and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,327,612 to Watanabe.

a. As per claim 21 and 23, Watanabe teaches receiving as input from a sender the e-mail message and the attachment for transmission to a recipient (See col. 4, lines 65-67); receiving as input from the sender an instruction indicative of whether to save the

Art Unit: 2141

attachment (See col. 3, lines 58-62); sending the e-mail message and the attachment to the recipient; and responsive to the instruction indicating not to save the attachment, saving the e-mail message without the attachment (See col. 3, lines 1-13).

b. As per claim 22, Watanabe teaches processing an electronic mail (e-mail) message having an attachment, comprising: a data port (See col. 4, lines 65-67, Remarks: Watanabe teaches a mail server that is accepting data from a mail client, it is inherent that Watanabe teaches a data port); a memory (See col. 7, lines 16-17); and a processor, arranged to receive from a sender an instruction indicative of whether to save the attachment, arranged to actuate the data port to send the e-mail message and the attachment to a recipient, and arranged to save the e-mail message in the memory without the attachment responsive to the instruction indicating not to save the attachment (See col. 15, lines 1-34).

c. As per claim 24, Watanabe teaches the claimed invention as described above. Furthermore, Watanabe teaches wherein saving the e-mail message, without the attachment comprises saving the e-mail message without the attachment on a computer of the sender (See col. 9, lines 5-24).

d. As per claim 25, Watanabe teaches the claimed invention as described above. Furthermore, Watanabe teaches wherein receiving the instruction as the input comprises receiving the instruction as the input at a time of writing of the e-mail message by the sender (See col. 8, lines 1-15).

Art Unit: 2141

e. As per claim 26, Watanabe teaches the claimed invention as described above.

Furthermore, Watanabe teaches wherein receiving the instruction as the input comprises receiving the instruction as the input at a time of sending of the e-mail message by the sender (See col. 8, lines 1-15).

f. As per claim 29, 34 and 40, Watanabe teaches the claimed invention as described above. Furthermore, Watanabe teaches comprising receiving as input from the sender a designation of a first set of one or more recipients and a designation of a second set of one or more recipients, wherein sending the e-mail message and the attachment to the recipient comprises sending the e-mail message and the attachment to the first set of one or more recipients; and sending the e-mail message without the attachment to the second set of one or more recipients (See col. 3, lines 32-55).

g. As per claims 30 and 36, Watanabe teaches the claimed invention as described above. Furthermore, Watanabe teaches wherein the processor is arranged to receive the instruction at a time of writing of the e-mail message by the sender (See col. 8, lines 1-15).

h. As per claim 31 and 37, Watanabe teaches the claimed invention as described above. Furthermore, Watanabe teaches wherein the processor is arranged to receive the instruction at a time of sending of the e-mail message by the sender (See col. 8, lines 1-15).

Art Unit: 2141

- i. As per claim 35, Watanabe teaches the claimed invention as described above. Furthermore, Watanabe teaches wherein the instructions, when read by the computer, cause the computer to save the e-mail message without the attachment on the computer (See col. 12, lines 11-65).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 27-28, 32-33, 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,327,612 to Watanabe in view of U.S. Patent No. 6,256,672 to Redpath.

- a. As per claims 27 and 38, Watanabe teaches the claimed invention as described above. However, Watanabe failed to teach wherein saving the e-mail message without the attachment comprises saving, with the e-mail message, information identifying the attachment.

Redpath teaches a method and system wherein saving the e-mail message without the attachment comprises saving, with the e-mail message, information identifying the attachment (see col. 3, lines 48-55).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein saving the e-mail message without the attachment comprises saving, with the e-mail message, information identifying the attachment as taught by Redpath in the claimed invention of Watanabe in order to provide a visual identification of attachments without the necessity of including the attachment data in the mail (See col. 1, lines 40-45).

b. As per claim 28, 33 and 39, Watanabe teaches the claimed invention as described above. However, Watanabe fails to teach wherein saving the e-mail message without the attachment comprises saving a name of the attachment with the e-mail message.

Redpath teaches wherein saving the e-mail message without the attachment comprises saving a name of the attachment with the e-mail message (See col. 3, lines 32-55).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein saving the e-mail message without the attachment comprises saving a name of the attachment with the e-mail message as taught by Redpath in the claimed invention of Watanabe in order to provide a visual identification of attachments without the necessity of including the attachment data in the mail (See col. 1, lines 40-45).

c. As per claim 32, Watanabe teaches the claimed invention as described above. However, Watanabe fails to teach wherein the processor is arranged to save information identifying the attachment with the e-mail message in the memory.

Art Unit: 2141

Redpath teaches wherein the processor is arranged to save information identifying the attachment with the e-mail message in the memory.

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the processor is arranged to same information identifying the attachment with the e-mail message in the memory as taught by Redpath in the claimed invention of Watanabe in order to

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Djenane M. Bayard whose telephone number is (571)

Art Unit: 2141


272-3878. The examiner can normally be reached on Monday- Friday 5:30 AM- 3:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Djenane Bayard

Patent Examiner


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER